



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: A8643 / ST9-99-153

SUN, Yudong

Appln. No.: 09/512,560

Group Art Unit: 2178

Confirmation No.: 6032

Examiner: Basehoar, Adam L.

Filed: February 24, 2000

For: SERVER-SIDE HTML CUSTOMIZATION BASED ON STYLE SHEETS AND  
TARGET DEVICE

**PRE-APPEAL BRIEF UNDER 37 C.F.R. § 41.41 REQUEST FOR REVIEW**

**MAIL STOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program (see July 12, 2005 *OG Notice*), and further to the: (1) August 24, 2005 Final *Office Action* (hereinafter "*Office Action*"); and (2) November 16, 2005 *Advisory Action* (hereinafter "*Advisory Action*"), Applicant submits this *Pre-Appeal Brief Request for Review*, along with a *Notice of Appeal*.

**1. Status of the Application**

Claims 1-30 are all the claims pending in the Application and stand rejected.

**2. 35 U.S.C. § 101 Rejection**

In the *Office Action*, claim 11 is rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully requests that this rejection be withdrawn, for at least the reasons discussed on page 2 of the October 24, 2005 *Response Under*

37 C.F.R. §1.116. The Examiner's only basis for rejecting the claims under 35 U.S.C. § 101 is that "[a]ll elements of the apparatus claim could be implemented in software alone" (*Office Action* @ par. 6). However, that is not the test for patentable subject matter. The correct test is whether the invention produces a "useful, concrete and tangible" result, which is clear from the claims. See *Ex parte Lundgren*, Appeal No. 2003-2088 (Bd. Pat. App. & Int. Sept. 28, 2005) and the USPTO's October 26, 2005 Pre-OG Notice *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*.<sup>1</sup>

### **3. Obviousness Rejection**

In the *Office Action*, claims 1-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over W3C's "Introduction to CSS2," (<http://www.w3.org/TR/REC-CSS2/intro.html#processing-model>; hereinafter "*Intro to CSS2*") in view of *Traughber et al.* (WO 98/14896; hereinafter "*Traughber*"). Applicant respectfully requests that this rejection be withdrawn, since the Examiner has omitted essential elements needed for a *prima facie* obviousness rejection (see pages 2-5 of the October 24, 2005 *Response Under 37 C.F.R. §1.116*).

### **3(a). The Combination Does Not Teach Or Suggest All Of The Claim Elements**

Applicant respectfully submits that the rejection of claims 1-30 in the *Office Action* does not establish a *prima facie* obviousness rejection because the applied references fail to teach or suggest all of the elements of the independent claims. Specifically, *Intro to CSS2* and *Traughber*, either alone or in combination, fail to teach or suggest independent claim 1's

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<sup>1</sup> [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

recitation<sup>2</sup> of applying “at least one rule of the style sheet to the DOM” in a document server, where the style sheet rule is directed to a target device.

Specifically, the only teaching or suggestion of the use of style sheets for a target device in either reference is in *Intro to CSS2*, which discloses the use of style sheets at the client side. *Intro to CSS2* does not teach or suggest the use of style sheets at the server side.<sup>3</sup> *Traughber* fails to even acknowledge that style sheets exist, let alone teach or suggest their application on either a client or server side. Thus, clearly, neither reference teaches or suggests the use of style sheets at a server side, and, even if the references could be combined as alleged by the Examiner, the combination would still be missing this feature. Accordingly, Applicants respectfully submit that the Examiner has not set out a *prima facie* case of obviousness for at least this reason.

**3(b). The Prior Art Does Not Supply The Motivation To Combine The References As The Examiner Alleges**

Applicant also respectfully submits that the rejection of claims 1-30 in the *Office Action* does not establish a *prima facie* obviousness rejection because the Examiner has not established the requisite motivation to combine the references as he alleges. Specifically, the Examiner has not identified any particular reason, supported by the applied references, why one of ordinary skill in the art at the time of the invention (hereinafter “one of skill”) would have been motivated

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<sup>2</sup> Independent claims 11 and 21 recite similar features.

<sup>3</sup> The Examiner seems to understand this deficiency, as he concedes that: (1) *Intro to CSS2* fails to teach or suggest “that customizing a requested document is done on the server side” (*O.A.*, p. 3 and p. 6); and (2) therefore, *Intro to CSS2* “alone lacks a proper motivation to customize documents on a document server instead of a client system” (*O.A.*, p. 6).

to change *Intro to CSS2*'s client side application of style sheets to a modified system where style sheets are applied at a server side, in view of some disclosure in *Traugher*.<sup>4</sup>

In this regard, Applicant respectfully submits that the Examiner has failed to provide any such motivation, as the Examiner does not allege (and indeed cannot allege) that *Traugher* specifically discloses any particular application of style sheets at either the client or server side, let alone any reason why the application of style sheets should occur on the server side. Rather, the Examiner only generally alleges that *Traugher* provides the requisite motivation in view of its alleged disclosure "that customizing the requested document can be done on the server side (Page 2, lines 3-14)(Fig. 2: 32)" (*O.A.*, pg. 3).

However, Applicant respectfully submits that, even if *Traugher* could be read as generally disclosing server side processing of web pages as the Examiner alleges, such general processing of web pages on a server is not relevant to the application of style sheets, as style sheets are a specific technique for dynamically customizing a web page for different display devices. *Traugher* does not even recognize that its HTML page can be modified for different display devices, let alone teach or suggest anything regarding the application of style sheets for such a purpose on either the client or server side.

Thus, since *Intro to CSS2* specifically discloses the benefits of applying style sheets at the client side, and since *Traugher* does not disclose any particular reason to modify *Intro to*

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<sup>4</sup> The Examiner must "show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453 (Fed.Cir. 1998). The mere fact that references can be "combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification]." *In re Mills*, 916 F.2d 680 (Fed.Cir. 1990); MPEP §2143.01.

CSS2's clear disclosure, Applicant respectfully submits that *prima facie* obviousness has not been established.


Further, as to alleged reasons which the Examiner offers in support of his proffered modification of *Intro to CSS2* in view of *Traugher*, i.e.,: (1) that such a modification "would provide the well known benefit of reducing the processing load on the client side;" and (2) that "[i]t was notoriously well known ... for servers to customize documents to be sent to clients for the purpose of advertisements or display capabilities by passing cookie data ... from the client to the server," neither is supported anywhere in the applied references (or even alleged to be supported in either reference by the Examiner). Accordingly, these reasons cannot be used in support of the instant rejection.

#### 4. Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-30 are allowable, and that the application now is in condition for allowance with all of the claims 1-30.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



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CUSTOMER NUMBER

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